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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,473	04/21/2004	Hiroya Fukuyama	12706/13	5144
23838	7590	10/03/2006	EXAMINER	
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			FINEMAN, LEE A	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,473

Applicant(s)

FUKUYAMA ET AL.

Examiner

Lee Fineman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 12 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to an amendment filed 17 July 2006 in which claims 11 and 12 were amended, claims 16-18 were added and claims 1-10 and 13-15 were cancelled. Claims 11-12 and 16-18 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-12 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo et al., JP2001198141 A in view of Shioda et al., US 6,081,371 (henceforth Shioda '371) and Shioda et al., US 2001/0055062 A1 (henceforth Shioda '062)

Kudo et al. disclose a microscopic observing apparatus (fig. 1) comprising: a probe microscope (33); an auxiliary microscope (2); a specimen stage (operating table 61 and floor as base) on which is placed a subject (32) of observation that is to be observed using the probe microscope and the auxiliary microscope that allows an absolute position of the subject of observation to be adjusted (via 3, 4, 5, 6, 7 and 8 around axes O₁, O₂, O₃, O₄, and O₅); a light irradiation device (not shown, see paragraph [0015] of machine translation) that irradiates light onto the subject (32) of observation, wherein the auxiliary microscope is located such that the light irradiated onto the subject of observation is visible (fig. 2); and a microscope holding member (3) that holds both of the probe microscope and the auxiliary microscope on the

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specimen stage (fig. 1), wherein the microscope holding member comprises a Z stage (5 and 62, see paragraph [0015] of machine translation) that stands upright on the specimen stage (fig. 1); a θ stage (6) that is mounted on a top end of the Z stage (fig. 1); an arm (7) that extends horizontally towards and above of the specimen stage, and that holds both of the probe microscope and the auxiliary microscope (fig. 1); a rotating member (8) that is linked to a distal end of the arm so as to be rotatable around a horizontal axis; the probe microscope is attached to the arm so as to face an upper surface of the specimen stage (figs. 1 and 2), and the auxiliary microscope (2) is held such that an optical axis thereof intersects an optical axis of the probe microscope (fig. 2); and wherein the probe microscope (32) is held such that a distal end thereof appears at a substantially central position in a visual field of the auxiliary microscope (fig. 2).

Kudo et al. disclose the claimed invention except for the light source being a laser that is coaxial with the optical axis of the probe microscope and wherein the auxiliary microscope is a video microscope including a CCD camera with a macro lens.

Shioda '371 teach in fig. 1 a microscopic observing apparatus comprising: a probe microscope (3) and an auxiliary microscope (1) and wherein the auxiliary microscope is a video microscope including a CCD camera (12) with a macro lens (in so far as the images from the auxiliary microscope are of a lower magnification than those from the probe microscope - see figs. 3 and 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the CCD camera of Shioda '371 to the auxiliary microscope of Kudo et al. to be able to record the images from the auxiliary microscope for easier viewing with a monitor (Shioda '371, column 9, lines 39-43).

Shioda '062 teach a microscopic observing apparatus (figs. 53 and 54) comprising: a probe microscope (435) and an auxiliary microscope (401) and a laser light irradiation device 454) that irradiates light that is coaxial with the optical axis of the probe microscope (figs. 53 and 54) onto the subject of observation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the light source of Kudo et al. a laser light source and coaxial with the optical axis of the probe microscope as taught by Shioda '062 to examine specific specimen/subject characteristics via a particular wavelength (see Shioda '062 pages 16-17, sections [0280]-[0282].

Response to Arguments

3. Applicant's arguments with respect to claims 11 and 12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LAF

26 September 2006


MARK A. ROBINSON
PRIMARY EXAMINER